

Facsimile Transmission Form

To:

RECEIVED
CENTRAL FAX CENTER

OCT 11 2004

From:

Message: FAX

OCT 11 2004

PATENT
IBM Docket No. RSW9-2000-0024US1**In the United States Patent and Trademark Office****Date:** October 10, 2004**In re Application of:** Glenn Clement Aikens et al**Filed:** April 11, 2000**For:** Method, System and Program Product for Managing Network
Performance**Serial Number:** 09/547,273**Art Unit:** 2142**Examiner:** Prieto, Beatriz**Response to Notice of Non-Compliant Amendment**

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to another Notice of Non-Compliant Amendment mailed September 10, 2004.

The subject Notice appears to object to the fact that no remarks were submitted with the claims provided in a communication to the Office dated July 13, 2004, a communication which is labeled as an "amendment" and which apparently has been entered in the Office.

However, the July 13, 2004 communication was itself a response to July 8, 2004 Notice of Non-Compliant Amendment which objected only to errors in claim number references and apparently status identifiers. Applicant's response to the July 8, 2004 Notice included only a new list of claims for corrections to the numbers and the status identifiers. The Remarks from the amendment originally submitted on August 19, 2003 were not re-submitted because the July 8, 2004 Office Notice explicitly stated:

09/547,273 (RSW920000024US1)

- 1 -

PATENT
IBM Docket No. RSW9-2000-0024US1

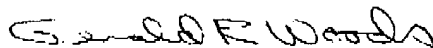
"Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire 'Amendments to the claims' section of applicant's amendment document must be re-submitted. 37CFR 1.121(h)"

As Applicants' attorney read the Notice of Non-Compliant Amendment, it would not have even been proper to resubmit the Remarks in the July 13, 2004 response since no changes were being made in the Remarks.

In an effort to satisfy what seem to be contradictory Office requirements, Applicants' attorney is resubmitting a Substitute Amendment which is intended as a complete replacement for the amendment originally submitted on August 19, 2003. Hopefully, the Substitute Amendment will satisfy Office requirements. A copy of the most recent Notice of Non-Compliant amendment is also being resubmitted.

What is not being provided are any comments of the type supposedly required by 37 CFR 1.530(e). That section applies only to *ex parte* reexamination proceedings, not to original examination proceedings. If the Examiner has some authority for the proposition that 37 CFR 1.530(e) applies to original examination proceedings, Applicants' attorney would like to receive the citation for that authority.

Respectfully Submitted,



Gerald R. Woods, Reg. No. 24,144
Attorney of Record

IBM Corporation
T81/503
PO Box 12195
Research Triangle Park, NC 27709
919-(919) 543 - 7204
FAX 919-254-4330

09/547,273 (RSW920000024US1)

- 2 -

PATENT
IBM Docket No. RSW9-2000-0024US1

In the United States Patent and Trademark Office

Date: August 19, 2003

In re Application of: Glenn Clement Aikens et al

Filed: April 11, 2000

RECEIVED
CENTRAL FAX CENTER

For: Method, System and Program Product for Managing Network
Performance

OCT 11 2004

Serial Number: 09/547,273

Art Unit: 2142

Examiner: Prieto, Beatriz

Substitute Amendment

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to an Office action mailed May 19, 2003.

The claims are being amended extensively to expedite prosecution of the application. The changes are detailed in a following **Amendments to the Claims** section. The amended claims are believed to be patentable over the art of record for reasons set forth in a following **Remarks** section.

No changes are being made in the specification or in the drawings.

09/547,273 (RSW920000024US1)

- 1 -